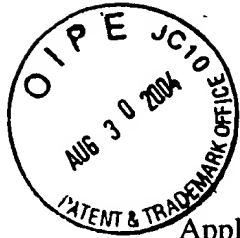


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PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Newnam et al. ) Examiner: R. Alvarez  
Serial No.: 09/536,518 ) Technology Center: 3600  
Filed: March 22, 2000 ) Art Unit: 3622  
Entitled: **A Method and System of Playing  
and Controlling a Contest for a  
Large Number of Simultaneous  
Contestants** ) Confirmation No.: 2014  
Atty. Docket No.: 109779-135

#19/  
Reply  
Brief  
9-1-04

CERTIFICATION UNDER 37 C.F.R. § 1.10

I hereby certify that the attached papers are being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" Mailing Label No. **EV507049775US** addressed to: **Mail Stop Appeal Brief - Patents**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

August 30, 2004

Date of Signature and of Mailing

*J. Ann Bergantino*  
Jo-Ann Bergantino

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed on June 29, 2004. This Reply Brief is being filed in triplicate.

**I. ARGUMENT**

The Examiner's Answer fails to address the basic legal defect that infects all of the Examiner's rejections – the failure to make a valid showing of a motivation to form even one of the combinations described by the claims. The Examiner asserts obviousness based on the NetPlay article plus official notice of facts not supported by any cited reference. Appellants' opening brief has shown that the NetPlay article, if anything, teaches away from the claimed invention and has also shown that the Examiner's officially noticed propositions are simply

untrue, disputable, or at the very least difficult to confirm or to deny. *See* A'nts Br. at pp. 9-11, 15-17.<sup>1</sup> Instead of addressing these defects by citing specific evidence in support of any of the challenged propositions, the Examiner has done little more than simply restate the officially noticed propositions or seek to support them with *additional* improper official notice. Further, the Examiner attempts to repair additional defects in the Examiner's hindsight-based arguments by making unsupported or incorrect assertions about what the NetPlay article discloses, while completely ignoring the fact that NetPlay's website declared that its games could accommodate only "*up to six people*," A'nts Br. App. D, att. F, at p. 1 (emphasis added). The Examiner's failure to present competent evidence to repair the demonstrated defects in her case means that the record continues to lack substantial evidence of non-patentability – and that the record certainly lacks evidence substantial enough to overcome Appellants' evidence of nonobviousness, A'nts Br. at pp. 11-14. Two experts have declared that the claimed invention – which determines a "unique winner" from a "large multitude of contestants" "in a fixed, short amount of time" – is "*not obvious*." A'nts Br. App. E at ¶ 10 (emphasis added); A'nts Br. App. F at ¶ 9 (emphasis added). The Examiner has presented no substantial evidence to the contrary. Given the defects in the Examiner's case and the weight of the evidence against it, all the claims at issue should be allowed.

**A. The Examiner's Continued Improper Use of "Official Notice" Cannot Provide the Substantial Evidence Needed to Reject Even Independent Claim 1.**

The Examiner relies on official notice to try to provide motivation to form a combination of elements lacking from NetPlay or any other cited art. The Examiner's Answer makes clear that the Examiner has failed to find any specific reference or set of references that even suggest the combinations of elements claimed by Appellants. Instead, the Examiner uses official notice of at least four different propositions to support rejection of claim 1 alone. These propositions include three previously noticed propositions: (1) that increasing the number of contestants makes competition "more fierce," Ex. Ans. at p. 9;<sup>2</sup> (2) that any "computer implemented" or, in the Examiner's current variation, any "Online, Internet based game" is "capable of producing a winner within a short period of time," Ex. Ans. at pp. 4, 8; and (3) that it is obvious that, to "build excitement," a game should "declar[e] a winner within a short period of time," Ex. Ans. at

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<sup>1</sup> "A'nts Br." stands for Appellants' opening brief, which was filed on April 13, 2004.

<sup>2</sup> "Ex. Ans." stands for the Examiner's Answer, which was mailed on June 29, 2004.

p. 10. They also include one newly noticed proposition: that restricting a game to a short time period increases the number of participants. Ex. Ans. at p. 10.<sup>3</sup> Because these four propositions are all relied on to support rejection of claim 1, and because all the other claims depend from claim 1, all the claims should be allowed if official notice with respect to *any* of these propositions is improper.

Appellants have demonstrated that *all* of the three previously noticed propositions are improper objects of official notice. See A'nts Br. at pp. 9-11. First, official notice is improper because these are not the *kind* of propositions with respect to which notice may be taken. The Examiner directly and heavily relies on these propositions as “core factual findings in a determination of patentability,” *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). But binding precedent establishes that such findings must be based on “concrete evidence in the record.” *Id.* Contrary to such precedent, the Examiner has provided no “concrete evidence” for these propositions, and has instead – and without even specifying a level of ordinary skill in the art – relied wholly on her own “assessment of what would be basic knowledge or common sense.” *Id.*

Moreover, *even if* the noticed propositions were of the proper kind for official notice, official notice of them is improper because they are either disputable or ***contradicted by actual facts***. See *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (stating that the court would construe “narrowly” the rule that official notice may be taken of facts “capable of such instant and unquestionable demonstration as to defy dispute”), *cited in Anderson v. Eppstein*, 59 U.S.P.Q.2d 1280, 1287 (Bd. Pat. App. & Interf. 2001). Appellants have already explicitly shown this with respect to at least the three previously noticed propositions. A'nts Br. at pp. 9-11.

The Examiner has not rebutted the Appellants' prior showings that official notice is improper. Nor has the Examiner cited any reference in support of the three propositions. With respect to the first proposition – that involving more contestants makes competition “more

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<sup>3</sup> The Examiner wrongly asserts that Appellants have conceded the propriety of the Examiner's official notice of various propositions regarding coupons, branded questions, collection of information, or points and prizes. Ex. Ans. at p. 11. Appellants' opening brief explicitly challenged these propositions as too vague and non-specific to support any determination of unpatentability, see *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), and in fact so vague and non-specific that they were “difficult even to confirm or to deny” – a characteristic that makes their official notice improper, MPEP § 2144.03, at p. 2100-136 (2004) (“It would not be appropriate for the examiner to take official notice...where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.”). A'nts Br. at pp. 16-17.

fierce” – the Examiner has added an irrelevant observation that “Netplay is an online multiplayer trivia tournament.” Ex. Ans. at p. 9. This observation does nothing to rebut Appellants’ showings that, in fact, increasing the number of contestants may dilute competition or may not affect competitiveness at all – as appears to have been case in “massive multiplayer online games” like Ultima Online and EverQuest that focused on role-playing, rather than competition. A’nts Br. at pp. 9-10.

With respect to the second proposition – that any “computer implemented” or, in the Examiner’s current variation, any “Online, Internet based game” is “capable of producing a winner within a short period of time” – the Examiner has essentially just *restated* the proposition. Ex. Ans. at p. 8. But Appellants have shown that computer-implemented games do not necessarily end quickly and, for a game designed along the lines of traditional poker, could even require several hours *per round of card play*. A’nts Br. at pp. 10-11. Further, insofar as a network such as the Internet is involved, problems of coordination and communication could frustrate any attempt at conducting a rapid-fire, massive-multiplayer competition. *See, e.g.*, A’nts Br. at p. 13.

Finally, with respect to the third proposition – that it is obvious to keep games short to “build excitement” – the Examiner now seeks to support this proposition by taking further official notice of the fourth proposition – that “ending a game and declaring a winner within a short period of time will motivate other players to play or for the same players to engage in further games because they will know that the games will not consume too much of their time.” Ex. Ans. at p. 10. However, the newly noticed proposition regarding the number of players is insufficient to establish the truth of the original proposition regarding the building of “excitement.” To achieve that end, the new proposition would, at the very least, need to be combined with some further notion that having more players makes competition “more fierce” – i.e., that another of the Examiner’s officially noticed propositions is true. But Appellants have already shown that official notice of such a “making competition fierce” proposition is itself improper. *Supra*, at 3-4.

In any event, even if the newly noticed proposition regarding player numbers could help to prove the originally noticed proposition regarding “excitement,” the newly noticed proposition is itself improperly noticed – first, because it represents yet another “core finding” unsupported by concrete evidence; and, second, because it is also disputable and apparently in conflict with

actual facts. “Massive multiplayer online games” like Ultima Online or EverQuest could last for months, A’nts Br. App. D, att. E, and, contrary to the Examiner’s assumption that short contest time’s necessarily favor larger numbers of contestants, a game that spans a large amount of time may allow *more* people to play simply because it permits them to participate at their convenience. Further, technical difficulties with conducting a *skill-based* competition within a short time could prevent such a time-confined competition from involving a large number of contestants. *See* A’nts Br. at p. 13 (noting surprise at the ability of Appellants’ system to “handle the hammering it takes with all these players connected simultaneously”). Hence, because the Examiner’s latest officially noticed proposition is at least disputable, it is also improperly noticed.

In sum, the Examiner has attempted to use official notice both to supply elements of the claimed invention missing from any cited reference and also to supply a motivation to form claimed combinations that are neither present in nor suggested by any cited art. Such use of official notice is contrary to the requirement that “core factual findings in a determination of patentability” be based on “concrete evidence in the record.” *In re Zurko*, 258 F.3d at 1386. Rejection of Appellants’ claims on such an inadequate hindsight-informed basis represents “both legal error and arbitrary agency action.” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

**B. The Examiner Continues to Make Unsupported Assertions Regarding the NetPlay Article’s Disclosure, and Continues to Fail to Provide Evidence That the NetPlay Article Discloses a Contest That Determines a “Unique Winner” from a “Large Multitude” in a Short Time.**

In addition to improperly using official notice, the Examiner’s arguments that independent claim 1 is obvious rely on unsupported assertions about the contents of the NetPlay article – the only prior art cited with reference to claim 1 and most of the dependent claims. If anything, the Examiner’s reliance on these assertions only highlights the lack of a substantial basis for the Examiner’s position.

To support rejection of the claims, the Examiner asserts that the NetPlay article discloses:

- (1) a capacity to “involv[e] a large number of Players,” Ex. Ans. at p. 7;

(2) a further “capacity to engage a large multitude in simultaneous competition within a short time,”<sup>4</sup> Ex. Ans. at p. 8; and

(3) the grouping of contestants “based [on] their skill levels,” Ex. Ans. at p. 9.

The first assertion is directly contradicted by record evidence showing that the NetPlay system could conduct games with only “*up to six people.*”<sup>5</sup> A’nts Br. App. D, att. F at p. 1 (emphasis added). The second assertion is simply not proven by the statement that “Netplay clearly teaches a tournament,” Ex. Ans. at p. 8, and, as discussed earlier, *supra*, at 2-4, cannot be established by improper official notice that, “since NetPlay is an Online, Internet based game[,] it is therefore capable of producing a winner within a short period of time,” Ex. Ans. at p. 8. The third assertion is similarly unsupported by the NetPlay article’s cited statement, *see* Ex. Ans. at p. 9, that NetPlay is “designed to attract people of all ages and skill levels,” A’nts Br. App. C at p. 1, ¶ 1. In any event, this third assertion does not establish that the NetPlay article made the disclosure originally claimed by the Examiner – namely, “matching contestants within a group subset into subcompetitions,” Ex. Ans. at p. 9. The Examiner now effectively argues only that the NetPlay article made such “matching” obvious, thus implicitly conceding that there is yet another claim element for which the Examiner has failed to provide concrete evidence of a motivation to combine. The fact remains that NetPlay does not disclose anything like the claimed invention’s short-time, massive-multiplayer contest.

**C. The Examiner Makes No Substantive Response to Two Expert Declarations and Other Substantial Evidence of the Nonobviousness.**

Appellants’ opening brief pointed out that the record contains substantial evidence of nonobviousness, including (1) two declarations from experts who indicated that the invention was “not obvious”; (2) commercial success; (3) existence of a long-unsatisfied need; (4) third-party acclamations; and (5) technical barriers and “known disadvantages” associated with a contest like that of the invention. A’nts Br. at pp. 11-13. The Examiner’s statement in response

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<sup>4</sup> At one point, the Examiner seems to suggest that the “short amount of time” limitation is effectively meaningless. Ex. Ans. at p. 8. But this suggestion is contrary to the evidence of record, including the Specification, which establishes that in this context the term “short amount of time” has a distinctive meaning. *See* A’nts Br. at p. 3, n. 2.

<sup>5</sup> Whether or not NetPlay may be “capable” of being somehow *modified* to “produc[e] a rapid multi-player contest,” Ex. Ans. at p. 9, is itself unclear, likely disputable, and ultimately beside the point, which is that NetPlay does not disclose, teach, or suggest a capacity to conduct such a contest – never mind such a contest involving a “large multitude.”

– “that the claims were not and are not rejected under 102” – does nothing to counter this evidence of nonobviousness. Ex. Ans. at p. 9. Further, the Examiner is wrong in suggesting that the “large multitude of contestants” aspect of the invention is obvious simply because “changing the size is obvious,” Ex. Ans. at p. 7. It is well known that specifying or changing numerical ranges associated with products or processes can establish patentability over prior art. *See, e.g., Crown Operations Int’l, Ltd v. Solutia, Inc.*, 289 F.3d 1367, 1378 (Fed. Cir. 2002). Thus, a limitation on a contest’s size is not *ipso facto* obvious as the Examiner contends. Further, as indicated by the declarations of two experts and third-party articles, it was a nontrivial task to devise a way to overcome the technical problems associated with shifting from a contest with, for example, NetPlay’s maximum of six contestants to a broadcast-level “large multitude” of contestants. *See* A’nts Br. at pp. 12-13; *see also* A’nts Br. App. E at ¶ 14; A’nts Br. App. F at ¶ 10. Hence, even if it were conceded that the Examiner’s use of the NetPlay reference and official notice somehow generated a *prima facie* case of obviousness, there would remain an un rebutted preponderance of evidence establishing the nonobviousness of claim 1, and hence of all the dependent claims.

**D. The Examiner Provides No Substantial Evidence to Support Rejecting Any Dependent Claims.**

**1. The Examiner’s New Claims That the NetPlay Article Discloses a “Server Node” and “Win, Lose, and Tie” Subcompetition Outcomes Are Unsupported.**

Like the Examiner’s arguments regarding the elements of independent claim 1, the Examiner’s new arguments that the NetPlay article discloses certain elements of the dependent claims lack support in the record. In particular, the Examiner’s assertion that the NetPlay article discloses a system that “equates to a server node” – as described in claims 4 through 16 – lacks support in any disclosure as to how NetPlay operates or how online systems generally and necessarily operate. Ex. Ans. at p. 11. In a computing network like the Internet, a task such as enforcement of a time deadline can, by definition, occur at any of a number of locations. *See* MICROSOFT COMPUTER DICTIONARY 168, 281 (5th ed. 2002) (definitions of “Internet” and “distributed processing”). Thus, the NetPlay article’s apparent disclosure of use of the Internet simply does not describe the required detail of a “server node” performing the claimed functions. Similarly, the NetPlay article does not disclose a massive multiplayer game played with the use of subcompetition outcome states that, as required by claim 2, include “at least the states win,

lose, *and* tie.” A’nts Br. app. A, at p. 1 (emphasis added). That the NetPlay article may implicitly disclose “*one* of the limitation of win, lose *or* tie,” Ex. Ans. at p. 10 (emphasis added), is not to the contrary.<sup>6</sup>

**2. The Examiner Continues to Fail to Provide Evidence of a Motivation to Combine “Time Stamping” with the Other Aspects of the Claimed Invention.**

In the Examiner’s first attempt to provide a basis for finding obvious the “time stamping” limitation of claims 4 through 6,<sup>7</sup> the Examiner takes official notice that “time-stamping is old and well known” in spelling bees. The Examiner provides no reason to believe that spelling bees are analogous art or that they used time stamping in a way substantially analogous to the claimed invention’s use of time stamping by “contestant nodes,” A’nts Br. App. A at p. 2. Hence, the Examiner’s “spelling argument” can provide no basis for finding a motivation to combine time stamping with the invention’s other elements. In any event, the Examiner’s assertion regarding spelling bees is yet another improperly noticed proposition. Appellants do not know of any prior-art spelling bee that used time stamping in a manner like that claimed. Nor do Appellants know of a reason why a traditional spelling bee – in which contestants are present in the same place – would need to use time stamping. The Examiner’s new “spelling bee” assertion is both unsupported and disputable, and is therefore an improper object of official notice, *supra*, at 3.

Further, the Examiner’s Answer implicitly concedes the inadequacy of its “spelling bee” argument by taking the extraordinary, and ordinarily prohibited, step of using newly cited art to provide a new ground for rejection on appeal, *see* MPEP § 1208.01, at p. 1200-25. But the newly cited art – U.S. Patent No. 5,970,143 (“the ’143 patent”) – is insufficient for its purpose. Although it discloses the use of time stamping, the cited discussion in the ’143 patent, Ex. Ans. at p. 10, does not disclose the use of time stamping as specifically described in claim 4 – i.e., use of time stamping by “contestant nodes” to record “receipt of [a] competition task” as part of a

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<sup>6</sup> The Examiner’s further presumption that a competition that produces a unique winner must have subcompetitions with “win” outcomes, Ex. Ans. at pp. 10-11, is untrue: a unique winner could be determined without subcompetitions based on a single free-for-all, or – as indicated by art newly cited by the Examiner – based on subcompetitions that simply report scores, rather than “winners,” *see, e.g.*, U.S. Patent No. 5,970,143, col. 2, l. 58, to col. 3, l. 3 (describing “tournaments” in which “a winner” is apparently selected based on transmitted “scores”).

<sup>7</sup> Despite the Examiner’s contrary assertion, Ex. Ans. at p. 10, the Examiner’s prior statements regarding deadlines did not address “time stamping.” The two are not equivalent: enforcement of a time limit does not require “time stamping.” *See, e.g.*, U.S. Patent No. 5,970,143, col. 39, ll. 40-65 (discussing enforcement of time limits by using contestant nodes to “trac[k] the elapsed time”).



massive multiplayer competition occurring within “a fixed, short amount of time,” A’nts Br. App. A at p. 2. *See* ’143 Patent, col. 39, l. 38, to col. 40, l. 16. Further, the cited discussion fails otherwise to provide a motivation to combine time stamping with the sort of time-limited, massive-multiplayer competition at issue here.

**E. The Examiner Improperly Asserts That All the Claims Stand or Fall Together.**

The Examiner improperly asserts that claims 1 through 16 “stand or fall together because appellant’s brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.” Ex. Ans. at p. 2. Contrary to the Examiner’s assertion, Appellants’ opening brief explicitly states, “Except for claims 9 and 10, the claims presented on appeal do not stand or fall together,” A’nts Br. at p. 4, and Appellants’ opening brief further asserts that, except for claims 9 and 10, each of claims 1 through 16 “is separately patentable from the other claims.” A’nts Br. at p. 4. In conformity with 37 C.F.R. § 1.192(c)(7), Appellants’ opening brief then explains why the claims “are believed to be separately patentable” – the basic reason being that each recites a unique combination of elements for which no *prima facie* case of obviousness – in particular, no motivation to combine – has been established. A’nts Br. at p. 14. Four separate subsections of Appellants’ opening brief then present specific reasons why claims 2 through 16 are separately patentable from claim 1 and, with certain exceptions, from each other.<sup>8</sup> A’nts Br. at pp. 14-17.

Because Appellants’ opening brief explicitly states that appealed claims “do not stand or fall together,” A’nts Br. at p. 4, the Examiner should, according to the Manual of Patent Examining Procedure, have proceeded in one of three ways:

1. Agree with Appellants’ grouping of claims.
2. Find that Appellants’ opening brief does not state reasons supporting the separate patentability of separately grouped or entirely ungrouped claims; inform Appellants that the brief was not in compliance with 37 C.F.R. § 1.192(c)(7); and allow Appellants to correct any error. MPEP § 1206, at pp. 1200-11 to -13; *id.* § 1208, at p. 1200-22 (form ¶ 12.55.01 and accompanying note).
3. Recognize that Appellants have stated reasons supporting separate patentability, but disagree with those reasons, and explain the reasons for disagreement. MPEP § 1208, at pp. 1200-18, 1200-22 (form ¶ 12.55.02 and accompanying note).

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<sup>8</sup> Claims 9 and 10 are not contended to be separately patentable from each other, but should be considered patentably distinct from the remaining claims. Other than the failure to show a lack of motivation to combine, Appellants have not provided additional specific reasons for claim 12 to be considered separately patentable from claim 7.

The Examiner has proceeded in none of these three permissible ways. Hence, Appellants' grouping of the claims should be considered to be effectively unchallenged.

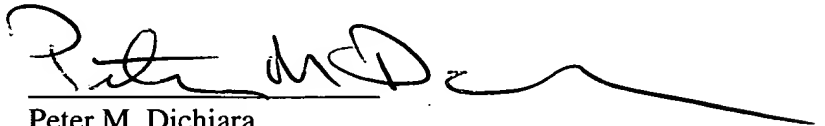
Indeed, Appellants' position is unchallenged in substance because the Examiner's Answer in fact addresses claims, and their limitations, separately. Rule 1.192 only indicates that claims are to be grouped to the extent they are rejected on the same ground. 37 C.F.R. § 1.192(c)(7) (discussing grouping of claims "[f]or each ground of rejection"). Because different grounds of rejection are provided for different claims, they cannot be considered to "stand or fall together."

## II. CONCLUSION

Appellants have shown fatal defects in the Examiner's hindsight-based effort to generate a case for obviousness by using official notice to make up for deficiencies in the NetPlay article's disclosure. The Examiner's Answer has neither rebutted Appellants' showing of these defects, nor cited concrete evidence to substitute for the Examiner's improper use of official notice. Under these circumstances, no *prima facie* case of obviousness can have been established. Moreover, the Examiner has presented no evidence substantial enough to overcome Appellants' own evidence of nonobviousness. Hence, Appellants request that the Board reverse the outstanding rejections under 35 U.S.C. § 103(a), remand the application to the Examiner, and direct the Examiner to issue a Notice of Allowance.

No additional fees are believed to be due. However, please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

Respectfully Submitted,

  
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Dated: August 30, 2004

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